

## REMARKS

Claims 1-20 are all the claims pending in the application, claims 19 and 20 having previously been added. Claims 1 and 15 are the only independent claims.

Claims 1-10 and 12-20 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Pecoraro (5,866,829) in view of the Furman Sound publication (Furman), and further in view of newly cited Stratton (6,538,185). Claim 11 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Pecoraro in view of Furman, Stratton, and Gillaspay (5,506,371). Applicant respectfully traverses these rejections, and requests reconsideration and allowance of the pending claims in view of the following arguments.

### Rejection under 35 U.S.C. §103(a) as being anticipated by Pecoraro, Furman, Stratton

Claims 1-10 and 12-20 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Pecoraro, Furman, and further in view of newly cited Stratton.

#### **Furman does not generate “control signals”**

Claim 1 requires that “each controller module of said plurality of individual foot controller modules generates a control signal in response to user operation of said individual foot controller module.” Page 2 of the Office Action concedes that Pecoraro does not teach the claimed “control signal” element and relies upon Furman to provide such teachings.

In particular, the Action indicates that Furman discloses that effects can be located on the pedal board or in a rack. The Action continues by stating that if the modules are located in a

rack, then “control signals” must be sent from the pedal board to the rack to activate the audio effect.

Applicant recognizes that Example 3 of Furman depicts remote stereo effects configured in a rack, and such effects are in communication with the output ports of a stereo patch bay. Applicant invites the Examiner’s attention to the stereo rack module of Example 3, as well as the signal flow diagram depicted in the figure on page 2. The signal flow diagram depicts a right-to-left audio signal flow path among the Furman Jacks. Operation of the Furman device is as follows.

The instrument signal is presented to the Furman “from guitar” jack, which is then directed to the audio input of the right-most effect box. The audio output of this right-most effect box is directly connected to the audio input of the left adjacent effect box. The audio output of this effect box is then directed to the audio input of the remote stereo effects in the rack via the Furman “Send” jack.

The remote stereo effects in the rack produces left and right stereo outputs that are provided to the two Furman “Return” jacks. These right and left stereo signals are then directed to the audio inputs of respective amplifiers. An audio signal routing arrangement is thus presented.

Applicant emphasizes that each of these jacks relate to audio signals, not control signals. In addition, Applicant has thoroughly reviewed the Furman reference and finds that this reference does not describe or even mention a single component (e.g., port, jack, cable, path, fiber, infra-red, radio link, etc.), which relates to a control signal. To the contrary, the entire Furman reference is focused on audio signals.

The Action contends that Furman provides “control signals” simply because modules can be located in a rack. However, the Action does not provide any support for such an assertion. Applicant respectfully requests clarification on this particular point. It is well settled in the law that when an Examiner asserts that there is an explicit or implicit teaching or suggestion in the prior art, the Examiner must indicate where exactly such teaching or suggestion appears in the reference. *See In re Rijckaert*, 28 U.S.P.Q.2d 1955, 1957 (Fed. Cir. 1993).

Applicant further submits that neither Pecoraro nor Stratton supply any of the stated deficiencies of Furman. Therefore, for the reasons presented above, even if one skilled in the art were to combine the teachings of the asserted references in the manner alleged, claim 1 would be patentable since all of the claim elements have not been taught or reasonably suggested.

Applicant notes that the forgoing is alone sufficient to establish the patentability of claim 1 over the cited references. However, Applicant provides the following additional comments with regard to this claim.

***Prima facie* case of obviousness has not been made**

Although the Examiner has combined Pecoraro in view of Furman and Stratton, Applicant asserts that a *prima facie* case of obviousness has not been made. To establish a *prima facie* case of obviousness, the Examiner bears the burden of demonstrating that (1) there is some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings; (2) there is a reasonable expectation of success; and (3) the prior art reference (or references when combined) must teach or suggest all the claim limitations. MPEP § 2143 (citing *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)). Furthermore, “[t]he mere

fact that references *can* be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.” MPEP 2143.01 (Citing *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990) (emphasis in original)).

There are three possible sources for a motivation to combine references: the nature of the problem to be solved, the teachings of the prior art, and the knowledge of persons of ordinary skill in the art.” MPEP § 2143.01 (citing *In re Rouffet*, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457-58 (Fed. Cir. 1998)).

It is well established that “[i]f [the] proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification.” MPEP § 2143.01 (citing *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984)). “If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. MPEP § 2143.01 (citing *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959)). Furthermore, “[i]t is improper to combine references where the references teach away from their combination.” MPEP § 2145 (citing *In re Grasselli*, 713 F.2d 731, 743, 218 USPQ 769, 779 (Fed. Cir. 1983)). A reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be led in a direction divergent from the path that was taken by the Applicant. See *In re Haruna*, 249 F.3d 1327, 1335, 58 USPQ2d 1517, 1522 (Fed. Cir. 2001). “A prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention. MPEP § 2141.02 (citing *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984) (emphasis in original)).

**All claim elements are not taught**

Claim 1 further requires that “each foot controller module of said plurality of individual foot controller modules is readily positionable within any of the plurality of predetermined mounting locations.”

Page 2 of the Action relies upon Furman as teaching “foot controller modules,” but recognizes that such modules are not readily positionable with any of a plurality of predetermined mounting locations since Furman utilizes Velcro as the mounting mechanism. The Action apparently recognizes that the Velcro mounting arrangement of Furman is not “predetermined” since a user can place foot pedals on the Velcro pad at most any location, none of which are “predetermined.” (Office Action, pg. 3). This point was made in Applicant’s last response.

The present Action now attempts to remedy this deficiency of Furman by further asserting the Stratton patent. In particular, the Action indicates that Stratton discloses the use of “predetermined mounting locations” and refers to “top right corner” and “top left corner” language of Stratton for support. (See, Stratton col. 3, lines 1-5).

Applicant’s review of the cited portions of Stratton reveals that indeed there is a discussion regarding positioning a component in left or right corners of a pedal board assembly. However, such description relates to the positioning of electrical box 27, not the positioning of foot pedals or sound effect generators. Stratton at best provides a suggestion to locate an electrical box at various locations associated with a pedal board assembly. More importantly, Stratton provides no teaching or suggestion relating to mounting locations of individual foot controller modules.

As noted above, a proper rejection under § 103 requires that the cited references must teach or suggest all the claim limitations. MPEP § 2143. Accordingly, even if one of ordinary skill in the art were to combine the teachings of these references in the manner asserted, claim 1 is believed to be patentable since the combined teachings do not result in the claimed “plurality of individual foot controller modules is readily positionable within any of the plurality of predetermined mounting locations.”

### **Teaching away**

Applicant further submits that Stratton teaches away from the claim 1 aspect that “each foot controller module of said plurality of individual foot controller modules is readily positionable within any of the plurality of predetermined mounting locations.” Applicant assumes, for the sake of argument, that the foot pedals of Stratton disclose the foot controller modules of claim 1. Even if this were correct, Stratton emphasizes that such foot pedals are to be configured in a “semi-permanent” arrangement. In particular, Stratton provides:

“The pedal board assembly 1 permits sound effect generators, such as rack mount devices or foot pedals, to be wired into it and thus be a semi-permanent storage and use case.” (Col. 2, lines 57-60) (emphasis added).

Two points with regard to Stratton are now evident. Specifically, Stratton discloses (1) locating non-foot pedal components (electrical box 27) at various locations; and (2) locating foot pedals in a semi-permanent arrangement. Regardless of the teachings of Stratton relating to the location of electrical box 27, Applicant submits that one of ordinary skill would follow the guidance provided by Stratton only to the extent of locating foot pedals in a semi-permanent arrangement. Stratton therefore leads one of ordinary skill in a direction which is completely different than the invention recited in claim 1; namely, the “readily positionable” aspect of this

claim. Overwhelming CAFC precedent supports Applicant's position. Recall that a reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be led in a direction divergent from the path that was taken by the Applicant. See *In re Haruna*, 249 F.3d 1327, 1335, 58 USPQ2d 1517, 1522 (Fed. Cir. 2001).

If the Action relies upon Stratton disclosing the locating of electrical box 27 at various locations as providing the necessary suggestion to suggest that "each foot controller module of said plurality of individual foot controller modules is readily positionable," then the Action must also consider Stratton teachings relating foot controllers themselves. "A prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention. MPEP § 2141.02 (citing *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984) (emphasis in original). Considering Stratton, as a whole, leads one to configure foot pedals in a semi-permanent arrangement, which is completely divergent, and thus teaching away from, the "readily positionable" language of claim 1.

### **No suggestion to combine**

Recall that the present Action indicates that one of ordinary skill would be motivated to modify the Velcro pad and purported "foot controller modules" of Furman in such a manner that the foot controller modules are readily positionable within any of a plurality of predetermined mounting locations, as allegedly suggested by Stratton. Applicant submits that no suggestion exists to make the proposed modification to the Velcro pad of Furman for at least two reasons.

First, Furman caters to those who want to reposition pedals about various locations of the pedal board, which is formed with a Velcro sheet. Furman repeatedly emphasized the notion that

one is not bound to predetermined mounting locations for the foot controller modules. See, for example, the following passages of Furman:

“The Pedal Board . . . lets you leave everything powered up and patched together as you like” (Pg. 1, col. 1) (emphasis added).

“If you wish to reposition your pedals . . .” (Pg. 1, col. 2) (emphasis added).

“The Velcro system of attachment allows pedal to be repositioned if necessary.” (Pg. 1, col. 2).

Furman clearly provides for locating foot controller modules in a manner determined by a user. The purpose of the Furman device is to enable a user to reposition foot controller modules wherever they desire, not in some predetermined mounting location.

The present Office Action proposes the modification of the Furman system (non-predetermined locations) in such a manner that it permits foot controller modules that are positionable within any of a plurality of predetermined mounting locations. If such a modification were possible, it would obviate the purpose of Furman. In other words, Furman would be modified from a device which permits locating foot controller modules in non-predetermined locations, to a system which requires a user to locate such modules at predetermined locations.

Such an arrangement is counter to the stated purposes of Furman. It is well established that “[i]f [the] proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification.” MPEP § 2143.01 (citing *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984)). Applicant submits that the modification proposed by the Office Action would



render Furman unsatisfactory for its intended purpose (e.g., locating modules at non-predetermined locations).

Applicant further emphasizes that “If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. MPEP § 2143.01 (citing *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959)). The principle of operation Furman relates to user choice—i.e., locating controller modules at non-predetermined locations. The proposed change would cause a dramatic shift in operation of Furman by forcing users to locate such controller modules in predetermined locations.

The proposed changes would result in Furman being not only satisfactory for its intended purpose, but would also result in a significant change in the principle of operation of the Furman system. Controlling CAFC precedent compels a finding that no suggestion exists for the combination of Furman and Stratton, alone or in further combination with Pecoraro.

For the additional reasons presented above, Applicant has demonstrated that a *prima facie* case of obviousness has not been established, and claim 1 is therefore believed to be patentable. Independent claim 15 recites similar language, and is therefore also believed to be patentable for similar reasons. Dependent claims 2-10, 12-14, and 16-20 are further believed to be patentable at least by virtue of their respective dependencies on the patentable independent claims 1 and 15.

**Rejection Under 35 U.S.C. §103(a)**  
**as being unpatentable over Pecoraro, Furman, Stratton, and Gillasp**

The Examiner rejects claim 11 under 35 U.S.C. §103(a) as being unpatentable over Pecoraro in view of Furman, Gillasp, and Stratton. Applicant has demonstrated above that

Pecoraro , Furman, and Gillaspy do not teach or suggest various features recited in claim 1. Applicant further submits that Gillaspy does not supply any of the deficiencies of these references. Therefore, for the reasons presented above, even if one skilled in the art were to combine the teachings of Pecoraro, Furman, Stratton, and Gillaspy in the manner asserted, claim 11 would be patentable at least by virtue of its dependency upon patentable independent claim 1.

### **CONCLUSION**

In light of the above remarks, Applicant submits that the present Response places all claims of the present application in condition for allowance. Reconsideration of the application is requested.

If for any reason the Examiner finds the application other than in condition for allowance, the Examiner is requested to call the undersigned attorney at the Los Angeles, California, telephone number (213) 623-2221 to discuss the steps necessary for placing the application in condition for allowance.

Respectfully submitted,

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